

## REMARKS

The withdrawal of the previous rejections and the entry of new grounds of rejection over newly cited references has been noted.

The Examiner is thanked for indicating the allowability of claim 29 if claim 29 was rewritten in independent form. By this Amendment, the substance of claim 29 has been rewritten as new claim 30 which is a combination of claims 1 and 29.

In the Office Action, claims 1, 2, 4, 7, 23, 24, 26 and 27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Takata et al. (Takata) in view of Willey et al. (Willey) and claim 28 was rejected under 35 U.S.C. §103(a) as being unpatentable over Takata in view of Willey and further in view of Delfort et al. (Delfort).

Reconsideration is requested.

This Amendment has revised the kinematic viscosity of the base oil in claim 23, 24 and 26 from 20-200mm<sup>2</sup>/s at 40°C to 33-100mm<sup>2</sup>/s at 40°C. This amendment changes the nature of the claimed grease composition as the function of a grease depends heavily on the viscosity of its base oil.

The claimed invention is directed to a grease comprising a base grease and an additive, wherein the base grease comprises a base oil and a thickener. The base oil is selected from poly- $\alpha$ -olefin oil, mineral oil and ether oil where the base oil has a kinematic viscosity of 33-100mm<sup>2</sup>/s at 40°C. and the additive comprises inorganic bismuth compounds.

This strategic composition provides a greased rolling bearing which is primarily used in applications such as the electric auxiliary machines that are installed in automobiles where the operating conditions make bearings subject to flaking and reduced bearing life.

Takata was applied as teaching a grease composition for a rolling bearing which comprises a base oil having a kinematic viscosity of from 40 to 200mm<sup>2</sup>/s at 40°C where the base oil may be mineral or synthetic oil such as a polyalphaolefin oil. the grease The Willey patent was applied as teaching a grease for a rock bit rolling bearing where the grease comprised bismuth oxide extreme pressure additive present at a level of from 1-20% by weight with antiwear additives which comprise bismuth oxide and bismuth sulfate at a level of from 0.1 to less than 10% by weight. Willey stressed that his composition required the presence of High Viscosity Index polyalphaolefin (HVI PAO) base fluid.

Willey explained, beginning at paragraph [0069], that HVI PAO has a higher viscosity than PAO and exemplified the HVI PAO by reference to SPECTRASYN ULTRA® which is available from Exxon-Mobil. As shown by the attached specification sheet for SPECTRASYN ULTRA® 150-1000, these preferred HVI PAOs have a kinematic viscosity at 40°C of 1500mm<sup>2</sup>/s to 10,000 mm<sup>2</sup>/s or higher.

In the Examples of Willey, Test Greases containing a HVI PAO comprise a base oil which may have a kinematic viscosity of at least 200mm<sup>2</sup>/s at 40°C (Table 4, Test Grease 6). The base oils of these greases are different and Test Grease 3 is made with an ester oil which is outside of the claims of the present application. The base oils in amended claim 1 are required to have a kinematic viscosity of 33-100mm<sup>2</sup>/s at 40°C. For these reasons, there is no motivation to use the bismuth compounds of Willey in the compositions of Takata and the claimed gease compositions are not made obvious by the cited prior art.

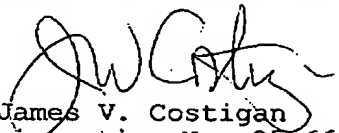
The Delfort patent is concerned with sulfonated bismuth compounds that are disclosed as additives for making overbased sulfonate products. It does not disclose any grease formulation.

For these reasons, the amended claims define an invention that is not disclosed or suggested by the cited prior

art. For these reasons, it is requested that this ground of rejection be withdrawn.

'An early and favorable action is earnestly solicited.

Respectfully submitted,



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